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PATENT APPLICATION

ATTORNEY DOCKET NO. 10014185-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): **Andrew M. Spencer, et al.**

Confirmation No.:

Application No.: **09/996,720**

Examiner: **C. CHASE**

Filing Date: **November 30, 2001**

Group Art Unit: **2189**

Title: **METHOD TO STORE AND RETRIEVE MEMORY CARD USAGE INFORMATION**

Mail Stop Appeal Brief - Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on January 30, 2006.

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

No fee is required for filing of this Reply Brief.

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Respectfully submitted,

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Atty. Dkt. No. 10014185-1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant: Andrew M. Spencer, et al.

Title: METHOD TO STORE AND RETRIEVE MEMORY CARD USAGE
INFORMATION

Appl. No.: 09/996,720

Filing Date: 11/30/2001

Examiner: C. CHACE

Art Unit: 2189

APPELLANTS' REPLY BRIEF

Mail Stop Appeal Brief -Patents

Commissioner for Patents
PO Box 1450
Alexandria, Virginia 22313-1450

Sir:

Scope of claim terms in general

An important issue in this appeal is the Examiner's interpretation of the scope of claims terms such as "about usage of a memory card" and "display" on a memory card. As discussed in detail in Appellants' Appeal Brief, the Examiner's interpretation of "about usage of a memory card" is unreasonably broad, and is inconsistent with the plain language of the claims, the specification, the file history of the application, and the interpretation of those skilled in the art. Likewise, the Examiner's interpretation of terms such as "display" on a memory card is unreasonably broad.

In the Examiner's Answer, the Examiner appears to suggest that specific disclosed examples of what is covered by a claim term cannot be used to assist in interpreting the claim term. Specifically, the Examiner states in the Answer on page 31, first full paragraph:

Appellants assert that the examples of what such usage may be should somehow limit what the phrase cannot be. Examiner respectfully disagrees. (emphasis in original).

Appellants respectfully submit, however, that the Examiner's statement is not an entirely accurate statement of Appellants' position, and further misses the point. As noted in the third full paragraph of Appellant's first Brief on Appeal, filed on November 18, 2004, the specification specifically distinguishes between information about the usage of a memory card, and other information that is merely stored on the memory card. Thus, the examples in the specification provide a limitation of not only what is covered by information about the usage of a memory card, but also what is not covered.

The point is that the specification discloses that not all information stored on a memory card is usage about a memory card merely because that information is, in fact, stored on the memory card. The Examiner's interpretation of information about the usage of the memory card is unreasonably broad and would essentially require that any information that is stored on a memory card be information about the use of the memory card merely because the memory may act to store the information. This interpretation is inconsistent with the present specification which provides an example of information stored on memory card which is not information about the usage of the memory card.

Further, the Examiner's proffered definition on page 31, second full paragraph, of the Answer that "[u]sage is the act or manner of using" also misses the actual claim limitation. Appellants have no quarrel with the Examiner's proffered definition of "usage". The phrase in dispute in the claims, however, is "information about usage of the memory card." Thus, the information stored on the memory card must be about usage of the memory card, not just information about other items, such as a DVD rental, etc., stored on the memory card.

Rejection of claims 1-6, 8-9, 12-13, 16-17, 23 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Bruce et al.

The Examiner also disagrees on page 33, second full paragraph of the Answer that modifying Bruce to include a sticker on card would render the Bruce device unfit for its intended purpose. However, the Examiner's suggestion on page 11, second full paragraph, of the Answer of removing the circuitry of Bruce so as to write memory slash marks on a sticker, would not allow for the wear leveling that is taught in Bruce to be performed in the Bruce device, and thus would be contrary to Bruce's intended purpose.

The Examiner's further suggestion on page 33, second full paragraph, of the Answer that one skilled in the art would modify Bruce to write count marks on a sticker, and then look at the marks, and save information in another memory appears to be without merit. The Examiner has provided no credible evidence as to why one skilled in the art would modify an electronic card, such as that of Bruce, to remove circuitry that keeps track of counts in favor of a sticker with slash marks, and then to have an operator of the card somehow try to save information based on these marks back onto the card.

In contrast to the assertions by the Examiner on page 34 of the Answer, Appellants further submit that one skilled in the art, upon review of the present application would clearly understand the term "display" to be a display electronically connected to other components of the memory card. The specification on page 8, lines 3-6 discloses:

In a further embodiment of the present invention, the reading and displaying step 30 could be performed at the host or at a display on the memory card, and substantially real-time information about usage could be displayed in a window on the screen at the host or at the memory card.

One skilled in the art would interpret the disclosure of a display in a window of a screen on a memory card, which displays in substantially real-time, to be a display electrically connected to the other components of the memory card. A sticker as a display, where a user is frantically scribbling slash marks, is not consistent with the description where a window, screen, or substantially real-time is described. Moreover, how would such a user obtain the information from the card to know what to scribble on the sticker?

Rejection of claims 20-22 and 24-25 under 35 U.S.C. § 103(a) as being unpatentable over Bruce et al.

The Examiner on page 39, first full paragraph of the Answer appears to suggest that an electronic display for a memory card is not supported by present specification. Appellants submit, however, that one skilled in the art would find the disclosure in the present specification fully enabling to one skilled in the art for providing an electronic display on a memory card. As the Examiner admits on page 22, second full paragraph, of the Answer, a display being a screen or window on a screen is known. One skilled in the art would readily be enabled to make a memory card with an electronic display displaying information based on the disclosure in the present specification as originally filed.

With regards to the electronic display, the Examiner on page 39, first full paragraph of the Answer appears to confuse the standards for obviousness and those for enablement and written description. The disclosure in the present specification regarding displaying information on a screen or window of the memory card, clearly provides written description and enablement support for claiming a display on the memory card. With respect to obviousness, however, it has not been Appellants' contention that one skilled in the art could not provide a display on the flash PC card of Bruce. Instead, Appellants contend that the Examiner has not provided evidence that one skilled in the art would be motivated to modify the flash PC card of Bruce to include a display thereon.

With respect to claims 20-22 and 24-25, the Examiner states on page 38, second full paragraph of the Answer that "[t]hese facts have already been clearly taken as admitted prior art." Appellants submit, however, that even if the existence of the particular elements provided in dependent claims 20-22 and 24-25 was known, such as the music and image files of claims 20-22, for example, the Examiner has not provided proper motivation as to why one skilled in the art would have modified the Bruce device to include the features.

The Examiner states on page 35, first full paragraph with respect to Bruce and claim 2, that "[w]ith respect to appellants' assertion that a power-on event requires more from a system than merely performing power on, examiner respectfully disagrees." Appellants' contention, however, has not been that a power-on event requires more from a system than

merely performing power on, but instead that a monitoring event requires more from a system than merely performing power on.

Rejection of claims 1-6, 8-9, 12-13, 16-17 and 20-22 under 35 U.S.C. § 103(a) as being unpatentable over Shimizu et al.

The Examiner suggests on page 36, first full paragraph of the Answer that under Appellants' interpretation, the monitor of Shimizu could be interpreted as a display on a memory card. Appellants, however, have never contended that a monitor separate from a memory card, could be interpreted as a display on a memory card.

Rejection of claims 14, 30 and 32 under 35 U.S.C. § 102(b) as being anticipated by Bruce et al.

The Examiner argues on page 28, first full paragraph of the Answer with respect to Bruce and claim 14, that Figure 6 of Bruce shows the write counts for a block of memory, and Figure 5 shows more than one block of memory. Appellants submit, however, that the "write counts" in Bruce are not an amount of memory. Thus, even if the "write counts" are stored in a memory of the Bruce device, the Bruce device would not meet the limitations of claim 14.

With respect to claims 30 and 32, The Examiner argues on pages 28-29, bridging paragraph of the Answer with respect to Bruce, that Bruce teaches preventing data from being corrected, and thus discloses that the number of times data is corrected is zero. This argument misses the point in that the number of times data is corrected in Bruce, even if zero, is not stored in a memory on the Bruce device.

For the foregoing reasons, it is submitted that the Examiner's rejections are erroneous, and reversal of the applied rejections are respectfully requested.

Respectfully submitted,

Date March 28, 2006

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